

II. REMARKS

Formal Matters

Claims 1, and 3-38 are pending after entry of the amendments set forth herein.

Claims 1-3 were examined and were rejected. Claims 4-15 were withdrawn from consideration.

Claims 1 and 3 are amended. The amendments to claims 1 and 3 were made solely in the interest of expediting prosecution, and are not to be construed as an acquiescence to any objection or rejection of any claim. Support for the amendments to claims 1 and 3 is found in the claims as originally filed, and throughout the specification, in particular at the following exemplary locations: claim 1: page 8, lines 5-6; page 46, lines 1-9; page 11, line 27 to page 12, line 9; claim 3: page 8, lines 14-16. Accordingly, no new matter is added by these amendments.

Claim 2 is canceled without prejudice to renewal, without intent to acquiesce to any rejection, and without intent to surrender any subject matter encompassed by the canceled claim. Applicants expressly reserve the right to pursue any canceled subject matter in one or more continuation and/or divisional applications.

Claims 16-38 are added. Support for new claims 16-38 is found in the claims as originally filed, and throughout the specification, including the following exemplary locations: claim 16: page 9, lines 10-17; claim 17: page 11, line 29 to page 12, line 2; claim 18: page 11, line 29 to page 12, line 2; claim 19: Figure 2; claim 20: page 8, lines 14-16; claim 21: page 9, lines 10-12; claim 22: page 11, line 29 to page 12, line 2; claims 23 and 24: page 11, line 29 to page 12, line 2; claim 25: Figure 4; claim 26: page 8, lines 14-16; claims 27-29: page 8, lines 19-20; claim 30: page 8, lines 18-22; claims 31-33: page 10, lines 13-19; claims 34-37: page 10, lines 20-24; claim 38: page 7, lines 24-26. Accordingly, no new matter is added by these new claims.

Applicants respectfully request reconsideration of the application in view of the remarks made herein.

Restriction requirement

The Office Action set out a restriction requirement as follows:

Group I: claims 1-3, drawn to a protein;

Group II: claims 4-7, drawn to a nucleic acid, expression cassette and cell comprising the nucleic acid;

Group III: claim 8, drawn to a method of expressing a protein;

- Group IV: claim 9, drawn to a monoclonal antibody;
- Group V: claim 10, drawn to a method of inhibiting a binding event;
- Group VI: claims 11 and 12, drawn to a method of modulating/inhibiting selectin binding in a mammalian host;
- Group VII: claim 13, drawn to a method of diagnosing a disease state;
- Group VIII: claim 14, drawn to a method of determining whether an agent inhibits sulfotransferase; and
- Group IX: claim 15, drawn to a non-human transgenic animal.

A provisional election of Group I claims was made with traverse. Applicants hereby affirm the election of Group I (claims 1-3) for prosecution on the merits. This election is made with traverse. As stated in the MPEP §803, if search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions. It is Applicants' position that it would not be unduly burdensome to perform a search on claims 1-15 together. Accordingly, Applicants traverse the restriction requirement.

Rejoinder

Applicants respectfully request rejoinder of method claims to the extent that they incorporate all the limitations of an allowed claim, as provided for under MPEP §821.04.

Rejection under 35 U.S.C. §102(b)

Claims 1 and 3 were rejected under 35 U.S.C. §102(b) as allegedly anticipated by Spiro et al. ((1996) *Biochem. J.* 319:209-216; "Spiro"). Claims 1-3 were rejected under 35 U.S.C. §102(b) as allegedly anticipated by Bierhuizen and Fukuda ((1992) *Proc. Natl. Acad. Sci. USA* 89:9326-9330; "Bierhuizen")

Claims 1 and 3 over Spiro

The Office Action stated that Spiro teaches a GlcNAc-6-sulfotransferase expressed in rats; and stated that Spiro anticipates claims 1 and 3. Applicants respectfully traverse the rejection.

Without conceding as to the correctness of this rejection, claim 1 is amended to recite "wherein said GST-3 is encoded by a polynucleotide comprising a nucleotide sequence which is at least 75%

identical to SEQ ID NO:01.” Spiro does not disclose a polypeptide encoded by a polynucleotide comprising a nucleotide sequence which is at least 75% identical to SEQ ID NO:01. Accordingly, Spiro cannot anticipate claims 1 and 3.

Claims 1-3 over Bierhuizen

The Office Action stated that Bierhuizen teaches a β GlcNAc sulfotransferase isolated from humans; and stated that Bierhuizen anticipates claims 1-3. Applicants respectfully traverse the rejection.

Bierhuizen discusses a β 1-6GlcNAc transferase, i.e., an enzyme that catalyzes the transfer of N-acetyl glucosamine to an acceptor saccharide, forming a β 1-6 linkage with the acceptor. Bierhuizen, page 9329, column 2, first full paragraph; and column 1, Table 1. The enzyme discussed in Bierhuizen is not a sulfotransferase. Accordingly, Bierhuizen cannot anticipate instant claims 1-3.

Conclusion as to the rejections under 35 U.S.C. §102(b)

Applicants submit that the rejection of claims 1-3 under 35 U.S.C. §102(b) has been adequately addressed in view of the remarks set forth above. The Examiner is thus respectfully requested to withdraw the rejection.

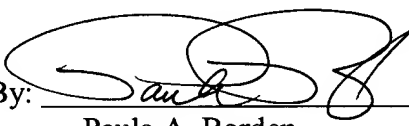
III. CONCLUSION

Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-0815, order number UCAL107CIP2.

Respectfully submitted,
BOZICEVIC, FIELD & FRANCIS LLP

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By: 
Paula A. Borden
Registration No. 42,344

BOZICEVIC, FIELD & FRANCIS LLP
200 Middlefield Road, Suite 200
Menlo Park, CA 94025
Telephone: (650) 327-3400
Facsimile: (650) 327-3231